

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Examiner: TBA
	)	
ICHIKAWA, Yoshitaka, et al.	)	Group Art Unit: 1623
	)	
Serial No.: 10/586,578	)	Docket No.: 8031-014-US
	)	
Filed: July 19, 2006	)	
	)	
For: Treatment of	)	
Degenerative Cartilage	)	
Conditions in a Mammal with	)	
Glycosidase Inhibitors	)	

Request of Correction of Errors on Filing Receipt

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Commissioner:

This Request is being submitted for the purpose of correcting numerous errors appearing on the Filing Receipt mailed May 11, 2007. Applicant respectfully requests the following corrections to the Filing Receipt:

The Filing Receipt indicates a filing date of September 25, 2006. The filing date of the application was July 19, 2006. We have enclosed a copy of the Transmittal Letter to the United States Designated/Elected Office Concerning Submission under 35 U.S.C. 371, in which the PCT recordation stamp shows the date July 19, 2006. Additionally, Applicant directs the attention of the Office to the Express Mailing date, which also shows the July 19,

2006 date. Therefore, Applicant requests a correction depicting the true filing date of July 19, 2006.

The Filing Receipt lists only one applicant. We have enclosed a copy of the Application Data Sheet under 37 CFR 1.76, mailed on July 19, 2006. The PCT recordation stamp shows the date July 19, 2006 as the date accorded for the above filing. Please correct the Filing Receipt to show the following applicants:

Yoshitaka Ichikawa, San Diego, CA  
Youe-Kong Shue, Carlsbad, CA  
Norman K. Orida, San Diego, CA  
Martin Lotz, La Jolla, CA  
Chi-Huey Wong, Rancho Santa Fe, CA  
Franklin W. Okumu, San Diego, CA  
San-Bao Hwang, Danshui, Taiwan


Please also correct the address for Applicant Yoshitaka Ichikawa from "San DIEgo" to "San Diego."

The Filing Receipt incorrectly spells a word in the title of the application. Please see the enclosed copy of the Application Data Sheet under 37 CFR 1.76 and the enclosed copy of the Transmittal Letter to the United States Designated/Elected Office Concerning Submission under 35 U.S.C. 371 (page 3), both mailed on July 19, 2006. This indicates that the correct spelling of "Glycosidase." Please change the spelling on the Filing Receipt from "Glycosidasc" to "Glycosidase."

It is believed that there are no fees due for this request. If this is not the case, please charge any additional fees, or credit any overpayments, to Deposit Account No. 502235. The Office may contact Applicant's representative at (858) 200-0586 for additional clarification.

Respectfully submitted,

Date: May 24, 2007

  
David M. Kohn, Esq.  
Reg. No.: 53,150

CATALYST LAW GROUP, APC  
9710 Scranton Road, Suite 170  
San Diego, California 92121  
(858) 450-0099  
(858) 450-9834 (Fax)

<b>TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371</b>		ATTORNEY'S DOCKET NUMBER 8031-014-US  U.S. APPLICATION NO. (If known, see 37 CFR 1.5) <b>102586578</b>
INTERNATIONAL APPLICATION NO. PCT/US2005/002017	INTERNATIONAL FILING DATE 20 January 2005	PRIORITY DATE CLAIMED 20 January 2004
TITLE OF INVENTION Treatment of Degenerative Cartilage Conditions in a Mammal with...		
APPLICANT(S) FOR DO/EO/US Ichikawa, et al.		
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:		
1. <input checked="" type="checkbox"/> This is a <b>FIRST</b> submission of items concerning a submission under 35 U.S.C. 371.		
2. <input type="checkbox"/> This is a <b>SECOND</b> or <b>SUBSEQUENT</b> submission of items concerning a submission under 35 U.S.C. 371.		
3. <input checked="" type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.		
4. <input type="checkbox"/> The US has been elected (Article 31).		
5. <input checked="" type="checkbox"/> A copy of the International Application as filed (35 U.S.C. 371(c)(2)) <ul style="list-style-type: none"> <li>a. <input checked="" type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau).</li> <li>b. <input checked="" type="checkbox"/> has been communicated by the International Bureau.</li> <li>c. <input checked="" type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US).</li> </ul>		
6. <input type="checkbox"/> An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)). <ul style="list-style-type: none"> <li>a. <input type="checkbox"/> is attached hereto.</li> <li>b. <input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4).</li> </ul>		
7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3)) <ul style="list-style-type: none"> <li>a. <input type="checkbox"/> are attached hereto (required only if not communicated by the International Bureau).</li> <li>b. <input type="checkbox"/> have been communicated by the International Bureau.</li> <li>c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired.</li> <li>d. <input type="checkbox"/> have not been made and will not be made.</li> </ul>		
8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).		
9. <input type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).		
10. <input type="checkbox"/> An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).		
Items 11 to 20 below concern document(s) or information included:		
11. <input type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98.		
12. <input type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.		
13. <input checked="" type="checkbox"/> A preliminary amendment.		
14. <input checked="" type="checkbox"/> An Application Data Sheet under 37 CFR 1.76.		
15. <input type="checkbox"/> A substitute specification.		
16. <input type="checkbox"/> A power of attorney and/or change of address letter.		
17. <input type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821-1.825.		
18. <input type="checkbox"/> A second copy of the published International Application under 35 U.S.C. 154(d)(4).		
19. <input type="checkbox"/> A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).		

U.S. APPLICATION NO. (Minimum fee of \$37 CFR 1.5)		INTERNATIONAL APPLICATION NO.		ATTORNEY'S DOCKET NUMBER	
TBD <b>10/586578</b>		PCT/US2005/002017		8031-014-US	
20. Other items or information:					
The following fees have been submitted				CALCULATIONS PTO USE ONLY	
21. <input checked="" type="checkbox"/> Basic national fee (37 CFR 1.492(a))..... \$300				\$	
22. <input type="checkbox"/> Examination fee (37 CFR 1.492(c))				\$	
If the written opinion prepared by ISA/US or the international preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4)..... \$0				\$	
All other situations..... \$200				\$	
23. <input type="checkbox"/> Search fee (37 CFR 1.492(b))				\$	
If the written opinion of the ISA/US or the international preliminary examination report prepared by IPEA/US indicates all claims satisfy provisions of PCT Article 33(1)-(4)..... \$0				\$	
Search fee (37 CFR 1.445(s)(2)) has been paid on the international application to the USPTO as an International Searching Authority..... \$100				\$	
International Search Report prepared by an ISA other than the US and provided to the Office or previously communicated to the US by the IB..... \$400				\$	
All other situations..... \$500				\$	
TOTAL OF 21, 22 and 23 =				\$	
<input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing in compliance with 37 CFR 1.821(c) or (e) or computer program listing in an electronic medium) (37 CFR 1.492(j)). The fee is \$250 for each additional 50 sheets of paper or fraction thereof.				\$	
Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof (round up to a whole number)	RATE	\$	
- 100 =	/50 =		x \$250	\$	
Surcharge of \$130.00 for furnishing any of the search fee, examination fee, or the oath or declaration after the date of commencement of the national stage (37 CFR 1.492(h)).				\$	
CLAIMS		NUMBER FILED	NUMBER EXTRA	RATE	\$
Total claims		41 - 20 =	21	x \$ 50	\$1050.00
Independent claims		4 - 3 =	1	x \$200	\$200.00
MULTIPLE DEPENDENT CLAIM(S) (if applicable)				+ \$360	\$0
TOTAL OF ABOVE CALCULATIONS =				\$	\$1980.00
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2.					
SUBTOTAL =				\$	\$990.00
Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(i)).				+	\$0
TOTAL NATIONAL FEE =				\$	\$990.00
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property				+	\$
TOTAL FEES ENCLOSED =				\$	\$150.00
				Amount to be refunded:	\$
				Amount to be charged	\$

10/586578

PATENT  
8031-014-US

EV669528867US

IAP11 Rec'd PCT/PTO 19 JUL 2006

Certificate of Express Mailing

Under 37 CFR 1.10, I certify that the attached correspondence is being deposited with the United States Postal Service as Express Mail No. EV 669528867 envelope addressed to: **Mail Stop: PCT**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Date: July 19, 2006

  
 Christina Dueñas
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Examiner: To Be Assigned
	)	
ICHIKAWA, Y. et al.	)	Group Art Unit: To be Assigned
	)	
Serial No.: U.S. National Stage of	)	Docket No.: 8031-014-US
PCT/US2005/002017	)	
	)	Date Mailed: July 19, 2006
Filed: Herewith	)	
	)	
For: Treatment of Degenerative Cartilage	)	
Conditions in a Mammal with Glycosidase	)	
Inhibitors	)	

TRANSMITTAL LETTER

Mail Stop: PCT  
 Honorable Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Dear Sir:

This submission is to effect entry of PCT Application PCT/US2005/002017 the United States National Stage under 35 U.S.C. § 371 and 37 C.F.R. § 1.495.

Accordingly, the following documents are transmitted:

1. Transmittal Letter for Submission under 35 USC 371 with Fee Sheet indicating a fee payment of \$150.00, reflecting the basic national stage fee of \$150.00 for a small entity under 37 C.F.R. § 1.492(a) (3 pages in duplicate);

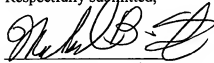
2. An Application Data Sheet under 37 C.F.R. § 1.76 giving biographical information on the inventors of the above-identified application as well as details of the claim for priority based on a previously-filed provisional application (3 pages); and
3. A copy of the above-identified PCT application. Because the above-identified PCT application was filed in the United States Patent and Trademark Office, the copy is not required under 37 C.F.R. § 1.495(b)(i). The copy is provided for convenience (33 pages);
4. A Preliminary Amendment under 37 C.F.R. § 1.121 to amend the specification and claims of the above-identified application for entry into the United States National Stage (9 pages); and
5. A Self Addressed Prepaid Stamped Postcard

Priority under 35 U.S.C. §§ 119 and 365 is hereby claimed for the national stage application. This priority is claimed to: (1) PCT Application No. PCT/US2005/002017 filed on January 20, 2005, and designating the United States; and (2) United States Provisional Patent Application Serial No. 60/531,168 filed on January 20, 2004, from which PCT Application No. PCT/US2005/002017 claimed priority.

Date:

July 19, 2006

Respectfully submitted,



Michael B. Farber, Ph.D., Esq.  
Reg. No.: 32,612

CATALYST LAW GROUP, APC  
9710 Scranton Road, Suite 170  
San Diego, California 92121  
(858) 450-0099  
(858) 450-9834 (Fax)

APPLICATION DATA SHEET UNDER 37 C.F.R. § 1.76

Applicant Information

- (a) Name: Yoshitaka Ichikawa  
Residence: San Diego, CA, USA  
Mailing Address: 4848 Algonquin Court, San Diego, CA 92130,  
USA  
Nationality: Japan
- (b) Name: Youe-Kong Shue  
Residence: Carlsbad, CA, USA  
Mailing Address: 7869 Via Teca, Carlsbad, CA 92130, USA  
Nationality: USA
- (c) Name: Norman K. Orida  
Residence: San Diego, CA, USA  
Mailing Address: 12867 Corbett Court, San Diego, CA 92130,  
USA  
Nationality: USA
- (d) Name: Martin Lotz  
Residence: La Jolla, CA, USA  
Mailing Address: P.O. Box 1513, La Jolla, CA 92038, USA  
Nationality: DE
- (e) Chi-Huey Wong  
Residence: Rancho Santa Fe, CA, USA  
Mailing Address: 6399 Calle Del Alcazar, Lot 209, Rancho Santa  
Fe, CA 92067, USA  
Nationality: USA



- (f) Name: Franklin W. Okumu  
Residence: San Diego, CA, USA  
Mailing Address: 3649 Victor Avenue, Oakland, CA 94619, USA  
(This inventor's address has changed from that stated on the PCT application at 3066 Palm Street, San Diego, CA 92104, USA)  
Nationality: USA
- (g) San-Bao Hwang  
Residence: Danshui, Taiwan  
Mailing Address: No. 174 Ba Shr Road Sect. 1, Danshui, Taiwan  
Nationality: USA

Correspondence Information

Catalyst Law Group, APC  
Customer Number: 32301

Application Information

- (a) Title: Treatment of Degenerative Cartilage Conditions in a Mammal with Glycosidase Inhibitors"
- (b) Total Number of Specification Pages: 25
- (c) Total Number of Claims Pages: 4
- (d) Total Number of Drawing Sheets: 3
- (e) Total Number of Abstract Pages: 1
- (f) Attorney Docket Number: 8031-014-US

- (g) Type of Application: Utility Application under 35 U.S.C. § 371.
- (h) Status of Disclosure of Information from Application under a Secrecy Order: No disclosure of any information from any application under secrecy order.

Representative Information

Customer Number: 32301

Priority Information

Priority under 35 U.S.C. §§ 119 and 365 is hereby claimed for the national stage application. This priority is claimed to: (1) PCT Application No. PCT/US2005/002017, filed on January 20, 2005, and designating the United States; and (2) United States Provisional Patent Application Serial No. 60/531,168 filed on January 20, 2004, from which PCT Application No. PCT/US2005/002017 claimed priority.

Assignee Information:

- a) Optimer Pharmaceuticals, Inc., 10110 Sorrento Valley Road, Suite C, San Diego, CA 92121; and
- b) The Scripps Research Institute, 10550 North Torrey Pines Road La Jolla, CA 92037.



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
PO Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING or 371 (6) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY DOCKET NO	TOT CLAIMS	IND CLAIMS
10/586,578	09/25/2006 07/19/2006	1623	150	8031-014-US	41	4

CONFIRMATION NO. 6168

## FILING RECEIPT

32301

CATALYST LAW GROUP, APC  
9710 SCRANTON ROAD, SUITE S-170  
SAN DIEGO, CA 92121

Date Mailed: 05/11/2007

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Yoshitaka Ichikawa, San Diego, CA;

Youe-Kong Shue, Carlsbad, CA

Norman K. Orida, San Diego, CA

Martin Lotz, La Jolla, CA

## Assignment For Published Patent Application

Optimer Pharmaceuticals, Inc., San Diego, CA  
The Scripps Research Institute, La Jolla, CA

Chi-Huey Wong, Rancho Santa Fe, CA

Franklin W. Okumu, San Diego, CA

San-Bao Hwang, Danshui, Taiwan

Power of Attorney: The patent practitioners associated with Customer Number 32301

## Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US05/02017 01/20/2005  
which claims benefit of 60/531,168 01/20/2004

## Foreign Applications

If Required, Foreign Filing License Granted: 05/11/2007

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is  
**US10/586,578**

Projected Publication Date: 08/23/2007

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*

Title

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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### LICENSE FOR FOREIGN FILING UNDER

#### Title 35, United States Code, Section 184

#### Title 37, Code of Federal Regulations, 5.11 & 5.15

#### GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.